

REMARKS

In the Office Action, the Examiner issued a final rejection of Claims 1-21, which are all of the pending claims, over the prior art. In particular, Claims 1-13 were rejected under 35 U.S.C. 103 as being unapentable over U.S. Patent 6,611,812 (Hurtado, et al.) in view of U.S. patent 6,247,127 (Vandergeest), and Claims 14-21 were rejected under 35 U.S.C. 102 as being fully anticipated by Hurtado, et al alone.

The rejection of Claims 1-13 is respectfully traversed because Hurtado, et al. is not prior art, for purposes of 35 U.S.C. 103, as to the present application. Also, Applicants herein ask that independent Claims 14, 18 and 20 be amended to better define the subject matters of these claims.

For the reasons set forth below, Claims 1-21 patentably distinguish over the prior art and are allowable. The Examiner is thus asked to enter this Amendment, to reconsider and to withdraw the rejection of Claims 1-13 under 35 U.S.C. 103 and the rejection of Claims 14-21 under 35 U.S.C. 102, and to allow Claims 1-21.

As indicated above, Applicants ask that the rejections of Claims 1-13 under 35 U.S.C. §103 be withdrawn because Hurtado, et al. is not a proper reference that can be applied under 35 U.S.C. §13. This, in turn, is because the present application and Hurtado, et al. are assigned to the same corporation, IBM Corporation. Applicants submit that the filing of the present application on September 22, 2000, brings the subject application under the rubric of the amendments made to the Patent Laws in the American Inventors Protection Act of 1999. That Act, enacted November 29, 1999, amends 35 U.S.C. 103(c) such that subject matter developed by another person which qualifies as prior art under 35 U.S.C. 102(e) does not preclude patentability where the subject matter and the claimed invention were, at the time

the invention was made, owned by the same person or subject to an application of assignment to the same person.

That this section applies to the instant application is established by the Guidelines concerning the implementation of changes to 35 U.S.C. 102(g) and 103(c) published in the Official Gazette on April 11, 2000. Those Guidelines includes the statement that the amendment to 103(c) applies to all utility, design and plant patent applications filed on or after November 29, 1999, including continuing applications filed under 37 C.F.R. 1.53(d), continued prosecution applications filed under 37 C.F.R. 1.53(b) and reissues. In view of the filing of the present application on September 22, 2000, under 37 C.F.R. 1.53(b), applicants benefit from the statutory restraints imposed in the amendment to 103(c).

That the claims of the present application are patentable over the rejection of record is established by the fact that Hurtado, et al. is, on its face, assigned to International Business Machines. The instant application is also assigned to International Business Machines. The Assignment of the instant application to International Business Machines by the applicants of the present application was mailed January 9, 2001 to the USPTO for recording. The Assignment was recorded by the USPTO on January 16, 2001, at Reel 011498, Frame 0308.

U.S. Patent 6,611,812 to Hurtado, et al. issued August 26, 2003. The present application is entitled to the benefit of the filing date of September 22, 2000. As such, the outstanding rejection of claims 1-13 of the present application applies the Hurtado, et al. patent predicated upon its availability as a reference under 35 U.S.C. 102(e) in that this is the only subsection of 35 U.S.C. 102 whose requirements are met by this patent.

In view of the requirements of 35 U.S.C. 103(c), as amended November 29, 1999, which apply to the instant application, the principal Hurtado, et al. reference cannot preclude patentability under 35 U.S.C. 103, the section upon which the claims 1-13 of the present application have been rejected. Thus, these claims of the present application are patentable over the outstanding rejection of record. Reconsideration and removal of this ground of rejection is therefore deemed appropriate. Such action is respectfully urged.

With respect to Claims 14-21, Applicants wish to note that there are a number of important differences between the present invention, as defined by these claims, and Hurtado, et al.

One important difference is that the certificate generator that Hurtado teaches bears no relationship to the one in this invention. The generator of the present invention generates a certificate after inspecting the application's code (i.e., instructions) and determining that a certain required property has been met. Hurtado does not teach the generation of certificates based on inspection of program code.

It is respectfully submitted that the present application and Hurtado, et al. use "code" in tow . The meaning of "code" in referenced context of Hurtado is simply a bit pattern that represents an action, like "Play" or "Copy". The meaning of the word "code" in the context of Claims 14-21 is "program" or "instructions".

In addition, the authenticator that Hurtado teaches authenticates the Secure Container, which carries the content. It does not authenticate the player application, as the present invention does. Hurtado does not teach player authentication.

Hurtado teaches the verification of content, not the

application handling the content (the "player"), as the preferred embodiment of the present invention does. The trust certificates used in the preferred embodiment of this invention pertain to the player, not the content, as do the Secure Container mechanisms taught by Hurtado.

Hurtado teaches mechanisms to verify communications among trusted parties. He does not teach a system to verify applications executing on the same machine as a trusted entity.

In addition, Hurtado teaches a system where the player is entrusted to decrypt the SCs. He does not teach a mechanism where a trusted content handler decrypts the SCs and then passes the content in the clear to an off-the-shelf player application, whose integrity must be verified.

Hurtado refers to user interfaces for the operators of content distribution sites. He does not teach how to control the user interfaces of end-user player applications in order to prevent violations of usage rights.

Also, Hurtado teaches mechanisms to verify the integrity of communications among the parties of a distribution system for protected content. He does not teach mechanisms that enable off-the-shelf player applications to be given protected content, ensuring that usage rights are enforced.

Hurtado teaches mechanisms to enable parties to verify that other parties are members of the same trusted system. This is not an objective of the present invention. With the present invention, an off-line verifier analyzes the program code of player applications to determine if they should be trusted, and this code analysis is the basis for issuing trust certificates.

Hurtado teaches communication mechanisms among the parties of a protected content distribution system. He does not teach how player applications (the applications that handle content on the end-users machine) are verified before being allowed to handle the content.

Hurtado teaches how the integrity of the content is verified, not the player application.

Hurtado does not teach how user interfaces of 3rd-party applications are controlled in order to prevent usage-rights violations. He only refers to the user interface of a web store for purchasing content, where there are no usage rights to enforce.

Independent Claims 14, 18 and 20 clearly describe features not shown or suggested in the prior art. In particular, each of these claims describes the feature that an off-line code verifier is used to analyze program code of a particular player application to determine whether that application is certified as a trusted application.

The other references of record have been reviewed, and they too, whether considered individually or in combination, also do not disclose or suggest this feature of the present invention.

Because of the above-discussed differences between Claims 14, 18 and 20 and the prior art, and because of the advantages associated with those differences, these claims patentably distinguish over the prior art and are allowable. Claims 15-17 are dependent from Claim 14 and are allowable therewith. Likewise, Claims 19 and 21 are dependent from, and are allowable with, Claims 18 and 20 respectively.

It is noted that the amendment requested herein only elaborate on features already described in the claims. In particular, these amendments elaborate on the function and purpose of the code verifier, which is already described in the claims. Accordingly, it is

believed that entry of this Amendment is appropriate, and such entry is respectfully requested.

In view of the above-discussion, the Examiner is asked to reconsider and to withdraw the rejection of Claims 1-13 under 35 U.S.C. 103 and the rejection of Claims 14-21 under 35 U.S.C. 103, and to allow Claims 1-21. If the Examiner believes that a telephone conference with Applicants' Attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,

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